

Atty. Dkt. No. 035451-0130 (3632.Palm)

**REMARKS**

Claims 1-20 remain pending in this application. Applicants respectfully request reconsideration of the present application in view of the reasons that follow. Because this response is being submitted within (2) months of the mailing date of the Office Action, a prompt Advisory Action is requested in the event that this reply is not found to place the present application in condition for allowance.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier for each claim.

**Claim Rejections – 35 U.S.C. § 103(a)**

- a. Rejection of claims 1, 3, and 14-16 based on Miller in view of Soini et al. and further in view of George et al.

In section 2 of the Office Action, claims 1, 3 and 14-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller (U.S. Patent No. 5,949,216) in view of Soini et al. (U.S. Published Patent Application No. 2002/0193152) and further in view of George et al. (U.S. Patent No. 4,684,870).

i. **Claims 1 and 3**

Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness with regard to claim 1 for at least two reasons. First, the cited combination of Miller in view of Soini et al. and further in view of George et al. fails to teach, disclose, or suggest all of the elements of claim 1 as combined therein. Second, there is no suggestion or motivation to modify Miller or to otherwise combine the teachings of Miller, Soini et al., and George et al. to arrive at the subject matter of claim 1.

Atty. Dkt. No. 035451-0130 (3632.Palm)

Specifically, claim 1 recites a “transceiver configured to send and receive data while the battery charge is below the low level and the recharger provides charge to the rechargeable battery and to the transceiver, the low level being a level at which the battery is unable to power the transceiver when the charge is below the low level.” The cited combination of Miller in view of Soini et al. and further in view of George et al. does not teach, disclose, or suggest a “transceiver configured to send and receive data while the battery charge is below the low level and the recharger provides charge to the rechargeable battery and to the transceiver, the low level being a level at which the battery is unable to power the transceiver when the charge is below the low level” as included in the combination of elements of claim 1.

The Office Action correctly acknowledges that:

Miller differs from claim 1 of the present invention in that it does not explicitly disclose the transceiver configured to send and receive data while the battery charge is below the low level, the battery unable to power the transceiver when the charge is below the low level, the recharger provides the charge to the rechargeable battery and to the transceiver, the low level being a level which the battery is unable to power the transceiver when the charge is below the low level.

However, the Office Action also states that “Sonoi et al teaches ... a transceiver configured to send and receive data while the battery charge is below the low level (inherent, since a warning is given to the user through the display when the battery drops below a pre-limit value [warning 32],” that “if the voltage over the battery drops further below preset limit value 2 warning 33, the multi-service mobile station cuts off power supply to the telephone module which are connected with the transmission and reception of messages by radio,” and that “data traffic is not cut off until the battery level drops below the preset limit value, (power off 35, taught in paragraph 0042 lines 1-5), the battery unable to power the transceiver when the charge is below the low level (paragraph 0040 lines 7-10).” However, while Sonoi et al. teaches several different battery warning levels, Sonoi et al. does not disclose a single “low level” below which radio transmission and reception of data continues while at the same time the battery is unable to

Atty. Dkt. No. 035451-0130 (3632.Palm)

power the radio transmission and reception of messages when the charge is below the low level. Thus, the combination of Miller and Sonoi et al. fails to teach, disclose, or suggest a "transceiver configured to send and receive data while the battery charge is below the low level and the recharger provides charge to the rechargeable battery and to the transceiver, the low level being a level at which the battery is unable to power the transceiver when the charge is below the low level" as included in the combination of elements of claim 1.

In fact, Sonoi et al. does not disclose any level below which a recharger provides charge to continue radio transmission and reception of data when the battery is unable to power the telephone module or other means for radio transmission and reception of data. Viewed as a whole, Sonoi et al. teaches battery management and data storage techniques wherein radio transmission and reception of data is limited to periods in which the battery is able power radio transmission and reception. By teaching in paragraph [0040] that "if voltage over battery 46 drops further below preset limit value 2 warning 33, the multi-service mobile station 1 cuts off power supply to means 42, which are connected with the transmission and reception of messages by radio," Sonoi et al. teaches away from use of a recharger to power the transmission and reception of data when the battery is unable to power the transmission and reception of data. As such, one of ordinary skill in the art would not have been motivated to combine Miller's charger with the battery management techniques of Sonoi et al. to somehow arrive at the subject matter of claim 1.

As to George et al., it fails to disclose any of the elements of claim 1 mentioned above that are lacking in the combination of Miller and Sonoi et al. The Office Action states that George et al. teaches "an apparatus for recharging a rechargeable battery in a hand held transceiver while maintaining communications capability through the transceiver when the rechargeable battery is unable to power the transceiver (abstract, col. 1 lines 9-18 and col. 1 lines 40-67)." George et al., however, discloses only "a rechargeable battery which requires periodic recharging due to normal transceiver use" (col. 1, and lines 9-18) and that "[t]he battery charger further includes charging circuit means for selectively charging the transceiver battery from a

Atty. Dkt. No. 035451-0130 (3632.Palm)

source of a first voltage during transmit mode and the source of a second, higher voltage during receive mode" (Col. 1, lines 49-53). George et al. does not disclose a "low level" below which the battery is unable to power the transceiver, and below which the transceiver is powered by the recharger. Thus, the cited combination of Miller in view of Soini et al. and further in view of George et al. fails to teach, disclose, or suggests of the elements of claim 1 as combined therein.

Furthermore, George et al. has nothing to do with radio transmission of data, but rather discloses "a conventional transceiver having a microphone, speaker, and ... a push-to-talk (PTT) switch ..." Col. 3, lines 28-34. George et al. discloses that "PTT switch 16 in the charger amplifier is used for selecting the operating modes of both the charger amplifier and the transceiver. Col. 4, lines 54-57. Thus, viewed as a whole, George et al. discloses only a conventional transceiver that requires a PTT switch for the transceiver to operate, and also to enable different charge levels for transmit and receive modes during charging. To modify the portable data phone of Miller to include the PTT switch-enabled battery charger of George et al. would, in effect, change a principle of operation of Miller (i.e., transmission and reception of data without the use of a PTT switch) and would also render Miller unsuitable for its intended purpose of transmitting and receiving data. Accordingly, one of ordinary skill in the art would not have been motivated to combine Miller's portable data phone with the PTT switch-enabled battery charger of George et al. to somehow arrive at the subject matter of claim 1, which also involves the radio transmission of data.

Thus, the combined teachings of Miller in view of Soini et al. and further in view of George et al. are not sufficient to render the subject matter of claim 1 *prima facie* obvious because the cited combination fails to teach, disclose, or suggest all of the elements of claim 1 as combined therein, and because there is no suggestion or motivation to modify Miller or to otherwise combine the teachings of Miller, Soini et al., and George et al. to arrive at the subject matter of claim 1. Any suggestion or motivation to combine or otherwise modify the teachings of Miller, Soini et al. and George et al. has been taken from Applicants' own disclosure using hindsight, which is improper. Accordingly, Applicants request that the rejection of claim 1 under

Atty. Dkt. No. 035451-0130 (3632.Palm)

35 U.S.C. § 103(a) be withdrawn. Additionally, claim 3 depends from claim 1, and is thus patentable over the cited combination of references for at least the same reasons, and Applicants further request that the rejection of claim 3 under 35 U.S.C. § 103(a) be withdrawn as well.

ii. **Claims 14-16**

Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness with regard to claim 14 for at least two reasons. First, the cited combination of Miller in view of Soini et al. and further in view of George et al. fails to teach, disclose, or suggest all of the elements of claim 14 as combined therein. Second, there is no suggestion or motivation to modify Miller or to otherwise combine the teachings of Miller, Soini et al., and George et al. to arrive at the subject matter of claim 14.

Specifically, claim 14 recites a "transceiver configured to send and receive data while the battery charge is below the low level and the recharging connector receives power from a power source and provides power to the rechargeable battery and to the transceiver, the low level being a level at which the battery is unable to power the transceiver when the charge is below the low level." The cited combination of Miller in view of Soini et al. and further in view of George et al. does not teach, disclose, or suggest a "transceiver configured to send and receive data while the battery charge is below the low level and the recharging connector receives power from a power source and provides power to the rechargeable battery and to the transceiver, the low level being a level at which the battery is unable to power the transceiver when the charge is below the low level" as included in the combination of elements of claim 14.

Atty. Dkt. No. 035451-0130 (3632.Palm)

The Office Action correctly acknowledges that:

Miller differs from claim 14 of the present invention in that it does not explicitly disclose the transceiver configured to send and receive data while the battery charge is below the low level, the battery unable to power the transceiver when the charge is below the low level, the recharger provides the charge to the rechargeable battery and to the transceiver, the low level being a level which the battery is unable to power the transceiver when the charge is below the low level.

However, the Office Action also states that "Sonoi et al teaches ... a transceiver configured to send and receive data while the battery charge is below the low level (inherent, since a warning is given to the user through the display when the battery drops below a pre-limit value [warning 32])," that "if the voltage over the battery drops further below preset limit value 2 warning 33, the multi-service mobile station cuts off power supply to the telephone module which are connected with the transmission and reception of messages by radio," and that "data traffic is not cut off until the battery level drops below the preset limit value, (power off 35, taught in paragraph 0042 lines 1-5), the battery unable to power the transceiver when the charge is below the low level (paragraph 0040 lines 7-10)." However, while Sonoi et al. teaches several different battery warning levels, Sonoi et al. does not disclose a single "low level" below which radio transmission and reception of data continues while at the same time the battery is unable to power the radio transmission and reception of messages when the charge is below the low level. Thus, the combination of Miller and Sonoi et al. fails to teach, disclose, or suggest a "transceiver configured to send and receive data while the battery charge is below the low level and the recharging connector receives power from a power source and provides power to the rechargeable battery and to the transceiver, the low level being a level at which the battery is unable to power the transceiver when the charge is below the low level" as included in the combination of elements of claim 14.

Atty. Dkt. No. 035451-0130 (3632.Palm)

In fact, Sonoi et al. does not disclose any level below which a recharger provides charge to continue radio transmission and reception of data when the battery is unable to power the telephone module or other means for radio transmission and reception of data. Viewed as a whole, Sonoi et al. teaches battery management and data storage techniques wherein radio transmission and reception of data is limited to periods in which the battery is able power radio transmission and reception. By teaching in paragraph [0040] that "if voltage over battery 46 drops further below preset limit value 2 warning 33, the multi-service mobile station 1 cuts off power supply to means 42, which are connected with the transmission and reception of messages by radio," Sonoi et al. teaches away from use of a recharger to power the transmission and reception of data when the battery is unable to power the transmission and reception of data. As such, one of ordinary skill in the art would not have been motivated to combine Miller's charger with the battery management techniques of Sonoi et al. to somehow arrive at the subject matter of claim 14.

As to George et al., it fails to disclose any of the elements of claim 14 mentioned above that are lacking in the combination of Miller and Sonoi et al. The Office Action states that George et al. teaches "an apparatus for recharging a rechargeable battery in a hand held transceiver while maintaining communications capability through the transceiver when the rechargeable battery is unable to power the transceiver (abstract, col. 1 lines 9-18 and col. 1 lines 40-67)." George et al., however, discloses only "a rechargeable battery which requires periodic recharging due to normal transceiver use" (col. 1, and lines 9-18) and that "[t]he battery charger further includes charging circuit means for selectively charging the transceiver battery from a source of a first voltage during transmit mode and the source of a second, higher voltage during receive mode" (Col. 1, lines 49-53). George et al. does not disclose a "low level" below which the battery is unable to power the transceiver, and below which the transceiver is powered by the recharger. Thus, the cited combination of Miller in view of Sonoi et al. and further in view of George et al. fails to teach, disclose, or suggests of the elements of claim 14 as combined therein.

Atty. Dkt. No. 035451-0130 (3632.Palm)

Furthermore, George et al. has nothing to do with radio transmission of data, but rather discloses "a conventional transceiver having a microphone, speaker, and ... a push-to-talk (PTT) switch ... ." Col. 3, lines 28-34. George et al. discloses that "PTT switch 16 in the charger amplifier is used for selecting the operating modes of both the charger amplifier and the transceiver. Col. 4, lines 54-57. Thus, viewed as a whole, George et al. discloses only a conventional transceiver that requires a PTT switch for the transceiver to operate, and also to enable different charge levels for transmit and receive modes during charging. To modify the portable data phone of Miller to include the PTT switch-enabled battery charger of George et al. would, in effect, change a principle of operation of Miller (i.e., transmission and reception of data without the use of a PTT switch) and would also render Miller unsuitable for its intended purpose of transmitting and receiving data. Accordingly, one of ordinary skill in the art would not have been motivated to combine Miller's portable data phone with the PTT switch-enabled battery charger of George et al. to somehow arrive at the subject matter of claim 14, which also involves the radio transmission of data.

Thus, the combined teachings of Miller in view of Soini et al. and further in view of George et al. are not sufficient to render the subject matter of claim 14 *prima facie* obvious because the cited combination fails to teach, disclose, or suggest all of the elements of claim 14 as combined therein, and because there is no suggestion or motivation to modify Miller or to otherwise combine the teachings of Miller, Soini et al., and George et al. to arrive at the subject matter of claim 14. Any suggestion or motivation to combine or otherwise modify the teachings of Miller, Soini et al., and George et al. has been taken from Applicants' own disclosure using hindsight, which is improper. Accordingly, Applicants request that the rejection of claim 14 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 15-16 depend from claim 14, and are thus patentable over the cited combination of references for at least the same reasons, and Applicants further request that the rejection of claims 15-16 under 35 U.S.C. § 103(a) be withdrawn as well.

- b. Rejection of claims 2 and 4-6 based on Miller in view of Soini et al. and further in view of George et al. and further in view of Hazzard et al.



Atty. Dkt. No. 035451-0130 (3632.Palm)

In section 3 of the Office Action, claims 2 and 4-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Soini et al. and further in view of George et al. and further in view of Hazzard et al. (U.S. Published Patent Application No. 2002/0163778). Claims 2 and 4-6 depend from claim 1. As stated above, the combination of Miller in view of Soini et al. and further in view of George et al. fails to render the subject matter of claim 1 *prima facie* obvious. As to Hazzard et al., it fails to make up for any of the deficiencies in the combination of Miller in view of Soini et al. and further in view of George et al. mentioned above. Thus, Applicants believe that claims 2 and 4-6 are patentable over the cited combination of Miller in view of Soini et al. and further in view of George et al. and further in view of Hazzard et al. for at least the same reasons as claim 3. Accordingly, Applicants request that the rejection of claims 2 and 4-6 under 35 U.S.C. § 103(a) be withdrawn.

**c. Rejection of claims 7-13 based on Soini et al. in view of Janik et al. and further in view of George et al.**

In section 4 of the Office Action, claims 7-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Soini et al. in view of Janik et al. (U.S. Published Patent Application No. 2002/0078248) and further in view of George et al. With regard to claim 7, Applicants respectfully submit that neither Soini et al. nor Janik et al. discloses, teaches, or suggests “providing power from the recharger to the transceiver of the handheld computer and the battery while the handheld computer is coupled to the recharger” and “establishing an RF link using the transceiver while the battery has a relatively low charge and the handheld computer is coupled to the recharger” as included in the combination of steps of claim 7.

Atty. Dkt. No. 035451-0130 (3632.Palm)

As to George et al., it does not disclose, teach, or suggest transmitting data over a radio frequency link from a handheld computer having a low battery charge. As the Office Action correctly acknowledges in response to Applicants' arguments filed June 9, 2005, George et al. does not explicitly disclose a handheld computer. However, the Office Action further states that George et al. "teaches a hand held transceiver such that the transceiver is configured to send and receive data while a recharger provides charge to a rechargeable battery (col. 1 lines 40-67)." Applicants respectfully disagree.

George et al. has nothing to do with radio transmission of data, but rather discloses "a conventional transceiver having a microphone, speaker, and ... a push-to-talk (PTT) switch ... ." Col. 3, lines 28-34. George et al. discloses that "PTT switch 16 in the charger amplifier is used for selecting the operating modes of both the charger amplifier and the transceiver. Col. 4, lines 54-57. Thus, viewed as a whole, George et al. discloses only a conventional transceiver that requires a PTT switch for the transceiver to operate, and also to enable different charge levels for transmit and receive modes during charging. To modify the multi-service mobile station of Sonoi et al. or the personal digital assistant of Janik et al. to include the PTT switch-enabled battery charger of George et al. would, in effect, change a principle of operation of Sonoi et al. and Janik et al. (i.e., transmission and reception of data without the use of a PTT switch) and would also render Sonoi et al. and Janik et al. unsuitable for their intended purposes of transmitting and receiving data. Accordingly, one of ordinary skill in the art would not have been motivated to combine the multi-service mobile station of Sonoi et al. or the personal digital assistant of Janik et al. with the PTT switch-enabled battery charger of George et al. to somehow arrive at the subject matter of claim 7, which also involves the radio transmission of data.

Accordingly, Applicants submit that no proper combination of Soini et al., Janik et al., and George et al. provides all of the steps recited in claim 7. Therefore, Applicants respectfully request that the rejection of claim 7 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 8-13 depend from claim 7, and are thus patentable over the cited combination of

Atty. Dkt. No. 035451-0130 (3632.Palm)

references for at least the same reasons as claim 7, and Applicants further request that the rejection of claims 8-13 under 35 U.S.C. § 103(a) be withdrawn as well.

**d. Rejection of claim 17 based on Miller in view of Soini et al. and further in view of George et al. and further in view of Huat**

In section 5 of the Office Action, claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Soini et al. and further in view of George et al. and further in view of Huat (U.S. Published Patent Application No. 2002/0133565). Claim 17 depends from claim 14. As stated above, the combination of Miller in view of Soini et al. and further in view of George et al. fails to render the subject matter of claim 14 *prima facie* obvious. As to Huat, it fails to make up for any of the deficiencies in the combination of Miller in view of Soini et al. and further in view of George et al. mentioned above. Thus, Applicants believe that claim 17 is patentable over the cited combination of Miller in view of Soini et al. and further in view of George et al. and further in view of Huat for at least the same reasons as claim 14. Accordingly, Applicants request that the rejection of claim 17 under 35 U.S.C. § 103(a) be withdrawn.

**e. Rejection of claims 18-19 based on Miller in view of Soini et al. and further in view of George et al. and further in view of Janik et al.**

In section 6 of the Office Action, claims 18-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Soini et al. and further in view of George et al. and further in view of Janik et al. Claims 18-19 depend from claim 14. As stated above, the combination of Miller in view of Soini et al. and further in view of George et al. fails to render the subject matter of claim 14 *prima facie* obvious. As to Janik et al., it fails to make up for any of the deficiencies in the combination of Miller in view of Soini et al. and further in view of George et al. mentioned above. Thus, Applicants believe that claims 18-19 are patentable over the cited combination of Miller in view of Soini et al. and further in view of George et al. and further in view of Huat for at least the same reasons as claim 14. Accordingly, Applicants request that the rejection of claims 18-19 under 35 U.S.C. § 103(a) be withdrawn.

Atty. Dkt. No. 035451-0130 (3632.Palm)

**f. Rejection of claim 20 based on Janik et al. in view of Soini et al. and further in view of George et al.**

In section 7 of the Office Action, claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Janik et al. in view of Soini et al. and further in view of George et al.

Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness with regard to claim 20 for at least two reasons. First, the cited combination of Janik et al. in view of Soini et al. and further in view of George et al. fails to teach, disclose, or suggest all of the elements of claim 1 as combined therein. Second, there is no suggestion or motivation to modify Janik et al. or to otherwise combine the teachings of Janik et al., Soini et al., and George et al. to arrive at the subject matter of claim 20.

Specifically, claim 20 recites "wherein the RF transceiver is configured to send and receive data while the battery charge is below the low level and the module receives power from a power source and provides power to the rechargeable battery and to the transceiver, the low level being a level at which the battery is unable to power the transceiver when the charge is below the low level." The cited combination of Janik et al. in view of Soini et al. and further in view of George et al. does not teach, disclose, or suggest "wherein the RF transceiver is configured to send and receive data while the battery charge is below the low level and the module receives power from a power source and provides power to the rechargeable battery and to the transceiver, the low level being a level at which the battery is unable to power the transceiver when the charge is below the low level" as included in the combination of elements of claim 20.

The Office Action correctly acknowledges that:

Janik et al. differs from claim 20 of the present invention in that it does not explicitly disclose the transceiver configured to send and receive data while the battery charge is below the low level, the battery unable to power the transceiver, the low level being a level which the battery is unable to power the transceiver when the charge is below the low level.

Atty. Dkt. No. 035451-0130 (3632.Palm)

However, the Office Action also states that "Sonoi et al teaches ... a transceiver configured to send and receive data while the battery charge is below the low level (inherent, since a warning is given to the user through the display when the battery drops below a pre-limit value 1 warning 32)," that "if the voltage over the battery drops further below preset limit value 2 warning 33, the multi-service mobile station cuts off power supply to the telephone module which are connected with the transmission and reception of messages by radio," and that "data traffic is not cut off until the battery level drops below the preset limit value, (power off 35, taught in paragraph 0042 lines 1-5), the battery unable to power the transceiver when the charge is below the low level (paragraph 0040 lines 7-10)." However, while Sonoi et al. teaches several different battery warning levels, Sonoi et al. does not disclose a single "low level" below which radio transmission and reception of data continues while at the same time the battery is unable to power the radio transmission and reception of messages when the charge is below the low level. Thus, the combination of Janik et al. and Sonoi et al. fails to teach, disclose, or suggest a "wherein the RF transceiver is configured to send and receive data while the battery charge is below the low level and the module receives power from a power source and provides power to the rechargeable battery and to the transceiver, the low level being a level at which the battery is unable to power the transceiver when the charge is below the low level."

In fact, Sonoi et al. does not disclose any level below which a recharger provides charge to continue radio transmission and reception of data when the battery is unable to power the telephone module or other means for radio transmission and reception of data. Viewed as a whole, Sonoi et al. teaches only battery management and data storage techniques wherein radio transmission and reception of data is limited to periods in which the battery is able power radio transmission and reception. By teaching in paragraph [0040] that "if voltage over battery 46 drops further below preset limit value 2 warning 33, the multi-service mobile station 1 cuts off power supply to means 42, which are connected with the transmission and reception of messages by radio," Sonoi et al. teaches away from use of a recharger to power the transmission and reception of data when the battery is unable to power the transmission and reception of data. As such, one of ordinary skill in the art would not have been motivated to combine the charger of

Atty. Dkt. No. 035451-0130 (3632.Palm)

Janik et al. with the battery management techniques of Sonoi et al. to somehow arrive at the subject matter of claim 20.

As to George et al., it fails to disclose any of the elements of claim 20 mentioned above that are lacking in the combination of Janik et al. and Sonoi et al. The Office Action states that George et al. teaches "an apparatus for recharging a rechargeable battery in a hand held transceiver while maintaining communications capability through the transceiver when the rechargeable battery is unable to power the transceiver (abstract, col. 1 lines 9-18 and col. 1 lines 40-67)." George et al., however, discloses only "a rechargeable battery which requires periodic recharging due to normal transceiver use" (col. 1, and lines 9-18) and that "[t]he battery charger further includes charging circuit means for selectively charging the transceiver battery from a source of a first voltage during transmit mode and the source of a second, higher voltage during receive mode" (Col. 1, lines 49-53). George et al. does not disclose a "low level" below which the battery is unable to power the transceiver, and below which the transceiver is powered by the recharger. Thus, the cited combination of Janik et al. in view of Sonoi et al. and further in view of George et al. fails to teach, disclose, or suggests of the elements of claim 20 as combined therein.

Furthermore, George et al. has nothing to do with radio transmission of data, but rather discloses "a conventional transceiver having a microphone, speaker, and ... a push-to-talk (PTT) switch ... ." Col. 3, lines 28-34. George et al. discloses that "PTT switch 16 in the charger amplifier is used for selecting the operating modes of both the charger amplifier and the transceiver. Col. 4, lines 54-57. Thus, viewed as a whole, George et al. discloses only a conventional transceiver that requires a PTT switch for the transceiver to operate, and also to enable different charge levels for transmit and receive modes during charging. To modify the personal digital assistant of Janik et al. to include the PTT switch-enabled battery charger of George et al. would, in effect, change a principle of operation of Janik et al. (i.e., transmission and reception of data without the use of a PTT switch) and would also render Janik et al. unsuitable for its intended purpose of transmitting and receiving data. Accordingly, one of

Atty. Dkt. No. 035451-0130 (3632.Palm)

ordinary skill in the art would not have been motivated to combine the portable data phone of Janik et al. with the PTT switch-enabled battery charger of George et al. to somehow arrive at the subject matter of claim 20, which also involves the radio transmission of data.

Thus, the combined teachings of Janik et al. in view of Soini et al. and further in view of George et al. are not sufficient to render the subject matter of claim 20 *prima facie* obvious because the cited combination fails to teach, disclose, or suggest all of the elements of claim 20 as combined therein, and because there is no suggestion or motivation to modify Janik et al. or to otherwise combine the teachings of Janik et al., Soini et al., and George et al. to arrive at the subject matter of claim 20. Any suggestion or motivation to combine or otherwise modify the teachings of Janik et al., Soini et al. and George et al. has been taken from Applicants' own disclosure using hindsight, which is improper. Accordingly, Applicants request that the rejection of claim 20 under 35 U.S.C. § 103(a) be withdrawn.

Atty. Dkt. No. 035451-0130 (3632.Palm)

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 9/26/2005By Chad E. Bement

FOLEY & LARDNER LLP  
Customer Number: 26371  
Telephone: (414) 297-5554  
Facsimile: (414) 297-4900

Chad E. Bement  
Attorney for Applicants  
Registration No. 54,991